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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,193	04/14/2004	Elizabeth Colbert	015291-147	5895
21839 7590 11/26/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER PLUMMER, ELIZABETH A	
			ART UNIT 3635	PAPER NUMBER
			NOTIFICATION DATE 11/26/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
debra.hawkins@bipc.com

## Office Action Summary

**Application No.**

10/824,193

**Applicant(s)**

COLBERT ET AL.

**Examiner**

Elizabeth A. Plummer

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/11/2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/11/2007 has been entered.

### ***Claim Objections***

2. Claims 1-68 are objected to because of the following informalities: Claims 1, 10, 19, 29, 37, 47, 56, and 63 recite the phrase, "having a D50 between about", which is unclear. Examination suggests amending the phrase to read, "having a mean diameter between about". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 43 and 52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 43 and 52 the thickener and water

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retention agent in the jointing material comprises hydroxypropyl methylcellulose, which is a cellulosic thickener. The parent claims, ie. claims 37 and 47, recite that the coating formulation of the skim coat does not contain any cellulosic thickener. As applicant describes in the specification, the jointing material comprises substantially the same solids as the coating formulation (page 3, paragraph 7) and that preferably the jointing material and skim coat have the same filler, binder, thickener, and other optional components (page 15, paragraph 52). In fact, the preferred embodiment of the coating formulation is just a diluted version of the jointing material (page 15, paragraph 51). Therefore, while support is given for a skim coat that comprises exclusively noncellulosic thickener and there is support for a jointing material that comprises cellulosic thickener, there is no support or written description in the specification for an interior construction system that simultaneously comprises a skim coat that cannot have a cellulosic thickener and a jointing material that comprises a cellulosic thickener. Furthermore, applicant appears to teach away from having a skim coat with a substantially different composition than the jointing material.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zuber et al. (PCT Publication WO 02/012144 A3) in view of Attard et al (US Patent 5,336,318).

a. Regarding claims 1 and 19, Zuber et al. discloses an interior construction system comprising one or more prefabricated drywall elements (page 1, lines 14-17; page 15, lines 7-10), at least one skim coat (page 15, lines 10-13) and at least one jointing material for assembling the one or more prefabricated drywall elements by jointing the drywall elements to form a substantially planar outer surface, wherein the jointing material, when dry substantially matches the skim coat (page 15, lines 10-19). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), a binder capable of being present in the amount of 1.0% to 4.0% by weight (page 10, line 16), a mineral filler (page 10, line 15) having a mean diameter between 5 and 35  $\mu\text{m}$  (page 8, line 12) and a thickener (page 9, 18-20). While Zuber et al. does not disclose that the thickener used in the jointing material and the corresponding skim coat comprises a noncellulosic thickener, it is notoriously well known in the art of jointing material that a noncellulosic thickener can be used to replace typical cellulosic thickeners. For example, Attard et al. teaches that is well known in the jointing material art that a polymeric noncellulosic thickener, such as a latex emulsion, can be used instead a cellulosic thickener (column 2, lines 1-5) in order to reduce batch lumping tendencies. It would have been obvious to one

ordinary skill in the art to modify Zuber et al. to replace the cellulosic thickener with a polymeric noncellulosic thickener, such as taught by Attard et al., in order to create a smoother coat.

b. Regarding claims 10 and 28, Zuber et al. discloses a method for the construction of an interior construction system comprising the steps of assembling prefabricated skim coated drywall elements by jointing material (page 1, lines 14-17; page 15, lines 7-10), wherein the skim coat (page 15, lines 10-13) and the jointing material substantially match when dry (page 15, lines 10-19), and drying the jointing material (page 20, line 4). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), a binder capable of being present in the amount of 1.0% to 4.0% by weight (page 10, line 16), a mineral filler having a mean diameter between 5 and 35  $\mu\text{m}$  (page 10, line 15) and a thickener (page 9, 18-20). While Zuber et al. does not disclose that the thickener used in the jointing material and the corresponding skim coat comprises a polymeric noncellulosic thickener, it is notoriously well known in the art of jointing material that a noncellulosic thickener can be used in combination with the normal cellulosic thickeners. For example, Attard et al. teaches that is well known in the jointing material art that a polymeric noncellulosic thickener, such as a latex emulsion, can be used instead a cellulosic thickener (column 2, lines 1-5) in order to reduce batch lumping tendencies. It would have been obvious to one ordinary skill in the art to modify

Zuber et al. to replace the cellulosic thickener with a polymeric noncellulosic thickener, such as taught by Attard et al., in order to create a smoother coat.

c. Regarding claim 37, Zuber et al. discloses an interior construction system comprising one or more prefabricated drywall elements (page 1, lines 14-17; page 15, lines 7-10), at least one skim coat (page 15, lines 10-13) and at least one jointing material for assembling the one or more prefabricated drywall elements by jointing the drywall elements to form a substantially planar outer surface, wherein the jointing material, when dry substantially matches the skim coat (page 15, lines 10-19). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), a binder (page 10, line 16), a mineral filler having a mean diameter between 5 and 35  $\mu\text{m}$  (page 10, line 15), an anti-cracking agent (page 9, lines 1-4), clay (page 9, lines 21-22), a thickener (page 9, 18-20), and talc (page 18, lines 18-19). While Zuber et al. does not disclose that the thickener used in the jointing material and the corresponding skim coat comprises a polymeric noncellulosic thickener or starch, it is notoriously well known in the art of jointing material that polymeric noncellulosic thickener can be used in place of normal cellulosic thickeners and starch can be used additional properties. For example, Attard et al. teaches that is well known in the jointing material art that a polymeric noncelulosic thickener, such as a latex emulsion, can be used instead a cellulosic thickener (column 2, lines 1-5) in order to reduce batch lumping tendencies. It would have been

obvious to one ordinary skill in the art to modify Zuber et al. to replace the cellulosic thickener with a polymeric noncellulosic thickener, such as taught by Attard et al., in order to create a smoother coat. Attard et al. also teaches that starch is a conventional binder and workability agent (column 4, lines 34-43). It would have been obvious to one of ordinary skill in the art to further modify Zuber et al. to include starch in order to increase the bond strength of the jointing material and skim coat. Furthermore, because the applicant fails to show critically for the different percentages of each member of the composition claimed, the weight percentages listed are considered a matter of obvious design choice.

d. Regarding claim 47, Zuber et al. discloses a method for the construction of an interior construction system comprising the steps of assembling prefabricated skim coated drywall elements by jointing material (page 1, lines 14-17; page 15, lines 7-10), wherein the skim coat (page 15, lines 10-13) and the jointing material form a substantially planar outer surface and substantially match when dry (page 15, lines 10-19), and drying the jointing material (page 20, line 4). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), a binder (page 10, line 16), a mineral filler having a mean diameter between 5 and 35  $\mu\text{m}$  (page 10, line 15), an anti-cracking agent (page 9, lines 1-4), clay (page 9, lines 21-22), a thickener (page 9, 18-20), and talc (page 18, lines 18-19). While Zuber et al. does not disclose that the thickener



used in the jointing material and the corresponding skim coat comprises a polymeric noncellulosic thickener or starch, it is notoriously well known in the art of jointing material that polymeric noncellulosic thickener can be used in place of normal cellulosic thickeners and starch can be used additional properties. For example, Attard et al. teaches that is well known in the jointing material art that a polymeric noncellulosic thickener, such as a latex emulsion, can be used instead a cellulosic thickener (column 2, lines 1-5) in order to reduce batch lumping tendencies. It would have been obvious to one ordinary skill in the art to modify Zuber et al. to replace the cellulosic thickener with a polymeric noncellulosic thickener, such as taught by Attard et al., in order to create a smoother coat. Attard et al. also teaches that starch is a conventional binder and workability agent (column 4, lines 34-43). It would have been obvious to one of ordinary skill in the art to further modify Zuber et al. to include starch in order to increase the bond strength of the jointing material and skim coat. Furthermore, because the applicant fails to show critically for the different percentages of each member of the composition claimed, the weight percentages listed are considered a matter of obvious design choice.

e. Regarding claim 56, Zuber et al. discloses an interior construction system comprising one or more prefabricated drywall elements (page 1, lines 14-17; page 15, lines 7-10), at least one skim coat (page 15, lines 10-13) and at least one jointing material for assembling the one or more prefabricated drywall elements by jointing the drywall elements to form a substantially planar outer

surface, wherein the jointing material, when dry substantially matches the skim coat (page 15, lines 10-19). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), an organic binder (page 9, line 12-14), a mineral filler having a mean diameter between 5 and 35 um (page 10, line 15), a silicate-based agent (page 9, lines 1-3; page 10, line 21), a hydrophobic agent which is a silicone derivative (page 9, lines 1-3; page 10, line 18), and polyvinyl alcohol (page 9, lines 12-14) and a thickener (page 9, 18-20), and talc (page 18, lines 18-19). While Zuber et al. does not disclose that the thickener used in the jointing material and the corresponding skim coat comprises a polymeric noncellulosic thickener, it is notoriously well known in the art of jointing material that polymeric noncellulosic thickener can be used in place of normal cellulosic thickeners. For example, Attard et al. teaches that is well known in the jointing material art that a polymeric noncellulosic thickener, such as a latex emulsion, can be used instead a cellulosic thickener (column 2, lines 1-5) in order to reduce batch lumping tendencies. It would have been obvious to one ordinary skill in the art to modify Zuber et al. to replace the cellulosic thickener with a polymeric noncellulosic thickener, such as taught by Attard et al., in order to create a smoother coat. Furthermore, because the applicant fails to show critically for the different percentages of each member of the composition claimed, the weight percentages listed are considered a matter of obvious design choice.

f. Regarding claim 63, Zuber et al. discloses a method for the construction of an interior construction system comprising the steps of assembling prefabricated skim coated drywall elements by jointing material (page 1, lines 14-17; page 15, lines 7-10), wherein the skim coat (page 15, lines 10-13) and the jointing material form a substantially planar outer surface and substantially match when dry (page 15, lines 10-19), and drying the jointing material (page 20, line 4). The skim coat comprises a matching composition to the jointing material except with about 10 to 60% additional water (page 17, line 22). The jointing material comprises water (page 11, line 4), an organic binder (page 9, line 12-14), a mineral filler having a mean diameter between 5 and 35  $\mu\text{m}$  (page 10, line 15), a silicate-based agent (page 9, lines 1-3; page 10, line 21), a hydrophobic agent which is a silicone derivative (page 9, lines 1-3; page 10, line 18), and polyvinyl alcohol (page 9, lines 12-14) and a thickener (page 9, 18-20), and talc (page 18, lines 18-19). While Zuber et al. does not disclose that the thickener used in the jointing material and the corresponding skim coat comprises a polymeric noncellulosic thickener, it is notoriously well known in the art of jointing material that polymeric noncellulosic thickener can be used in place of normal cellulosic thickeners. For example, Attard et al. teaches that is well known in the jointing material art that a polymeric noncellulosic thickener, such as a latex emulsion, can be used instead a cellulosic thickener (column 2, lines 1-5) in order to reduce batch lumping tendencies. It would have been obvious to one ordinary skill in the art to modify Zuber et al. to replace the cellulosic thickener with a polymeric noncellulosic

thickener, such as taught by Attard et al., in order to create a smoother coat.

Furthermore, because the applicant fails to show critically for the different percentages of each member of the composition claimed, the weight percentages listed are considered a matter of obvious design choice.

g. Regarding claims 2, 11, 20, 29, 38, 48, 57 and 64, the jointing material and the skim coat form a substantially homogeneous outer surface on the substantially planar outer surface (page 20, lines 6-9).

h. Regarding claims 3, 12, 21, and 30, at least one of the parameters in the group consisting of coloration, reflectance factor and surface water absorption is substantially homogeneous over the substantially planar outer surface (page 20, lines 9-13).

i. Regarding claims 4, 13, 22 and 31, the jointing material and the skim coat exhibit substantially the same surface water absorption when dry (page 20, lines 9-13).

j. Regarding claims 5, 14, 23, 32, 39, and 58, the surface water absorption, as measured by the drop test, is at least 45 minutes for both the jointing material and the skim coat (page 13, line 3; page 11, line 21-22; page 12, line 1-3).

k. Regarding claims 6, 15, 24, 33, 40, 49, 59, and 65, Zuber et al. discloses a coating formulation further comprising dispersant (page 10, line 22), anti-cracking agent (page 18, lines 18-20) and workability agent (page 18, line 17).

Because the applicant fails to show critically for the different percentages of each

member of the composition claimed, the weight percentages listed are considered a matter of obvious design choice.

l. Regarding claims 7, 16, 25, 34, 41, 50, 60, and 66, the anti-cracking agent is mica (page 18, lines 18-20) workability agent is clay (page 18, line 17; page 9, lines 21-22).

m. Regarding claims 8, 17, 26, 35, 42, 51, 61, and 67 the mineral filler comprises more than about 60% calcium carbonate (page 10, line 15; page 18, line 12).

n. Regarding claims 9, 18, 27, 36, 46, 55, 62, and 68, the drywall elements are gypsum wallboard (page 1, lines 16-17).

o. Regarding claims 44 and 53, the composition of the jointing material and the skim coat are the same, except for that the skim coat will generally comprise additional water (page 17, lines 18-22). Therefore the binder in the coating formulation of the skim coat and the binder in the jointing material will be the same.

p. Regarding claims 45 and 54, the binder in the jointing material can be an acrylic polymer (page 10, line 16-17).

### ***Response to Arguments***

7. Applicant's arguments filed 08/29/2007 have been fully considered but they are not persuasive. Regarding applicant's argument that Attard only teaches a jointing compound and not a skim coat, Zuber et al. explicitly teaches that in his interior construction system there is a jointing compound and a skim coat, wherein the

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composition of the skim coat matches the composition of the jointing material (page 15, lines 16-19). Therefore, if the jointing compound were to be altered, Zuber et al. would adapt the skim coat to match the new composition (page 15, lines 10-13) in order to achieve uniform characteristics. Regarding applicant's argument that Attard does not teach the use of a polymeric noncellulosic thickener at the exclusion of any cellulosic thickener, while not the preferred embodiment, Attard admits in the background of the invention that it is notoriously well known in the art of compounds to replace cellulosic thickeners with polymeric noncellulosic thickeners (column 2, lines 1-5).

#### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Plummer whose telephone number is (571) 272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/J. CHAPMAN/  
PRIMARY EXAMINER

EAP

*gpr*